

REMARKS/ARGUMENTS

The Examiner has rejected Claims 15-19 under 35 U.S.C. § 112, second paragraph, Claims 1-5, 8-9 and 11-12 under 35 U.S.C. § 102(b) as being anticipated by Main et al. (U.S. 5,533,661), and Claims 6-7, 10 and 15-18 under 35 U.S.C. § 103(a). Claims 1 and 15 are currently amended with the filing of this paper.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected Claims 15-19 as being indefinite for failing to include a lower limit to the length of the head section cover by the limitation "less than about 18mm." Claim 15 has been amended to include the range from 15mm to 18mm, and therefore is believed to overcome the present ground of rejection and otherwise in condition for allowance.

Rejection under 35 U.S.C. § 102(b) as anticipated by Main et al.

The Examiner has rejected Claims 1-5, 8-9 and 11-12 as being anticipated by Main et al. The Examiner asserts that a recessed portion is disclosed (by the decreased diameter section formed on the cylindrical body under the head section cover as shown in Fig. 1) which is capable of receiving an inner portion of an intestine or a circumferential length of tubular tissue. However, the device of Main et al. is structurally different from the device of the present invention. In the present device, the recessed portion is formed in the transition section between the head section cover and the cylindrical body such that the distance from the axis extending through the center of the transition section to the recessed portion is less than the distance from the axis to the cylindrical body. Main et al. simply does not disclose a structure where the radial distance within the transition section is less than the radial distance of the body section. It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the

claim is found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also MPEP § 2131. Therefore, the rejection based on anticipation by Main et al. has now been overcome.

In addition, the device of the present invention has a thinner head section cover (15 to 18 mm in the stapler of the present invention, as now claimed in Claims 15-19) so that the recessed portion 41 is positioned to receive the circumferential length of a small intestine. The combination of the smaller head section cover and the recessed portion as now claimed in Claim 1 provides for receiving a length of tubular tissue in a way that Main et al. cannot. Accordingly, the currently amended Claim 1 and all claims depending from Claim 1 are allowable over Main et al.

Rejection under 35 U.S.C. § 103(a) as obvious over Main et al.

Claims 6-7, 10 and 15-18 have been rejected as being unpatentable over Main et al. for substantially the same reasons as provided in the previous section. Claims 6-7 and 10, depending from currently amended Claim 1 or another claim depending from Claim 1, are now believed to be in condition for allowance. To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that 1) the references teach all of the elements of the claimed invention, 2) the references contain some teaching, suggestion or motivation to combine the references, and 3) the references suggest a reasonable expectation of success. See MPEP § 2142. See also In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); In re

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F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). There is no suggestion or motivation to provide a recessed portion as described and now claimed by the present amendment, and therefore any dependent claims are also non-obvious.

Similarly for Claims 15-18, which include the claim limitation of Claim 1 further describing the recessed portion, the currently amended claims are believed to overcome the ground for rejection.

Applicant submits that the original dependent claims provide additional reasons for allowance.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

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